

D. REMARKSInterview

Applicants wish to thank the Examiner and his supervisor for the courtesy extended to Applicants' attorney during the telephone interview of September 30, 2004.

Drawings

Applicants note with appreciation the acceptance of Applicants' formal drawings by the Examiner in the Office Action.

Specification

The specification has been amended to correct several, inadvertent typographical errors. No new matter has been added as a result of these amendments.

Summary

Claims 1-21 remain pending in the Application. Claims 1, 8, and 15 are independent claims.

Claim Rejections

Claims 1-4, 8-11, and 15-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cumbers, United States Patent No. 6,554,705 (hereinafter "Cumbers") in view of Musgrave et al., United States Patent No. 6,202,151 (hereinafter "Musgrave"). Claims 5-7, 12-14, and 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cumbers in view of Musgrave, and further in view of Maeno, United States Patent No. 5,283,644 (hereinafter "Maeno"). Applicants respectfully traverse the rejections.

Applicants teach and claim a system, method, and computer program product for identifying an individual based on biometric characteristics, and then sending a message to one or more recipients, where the message is based upon the characteristics of the identified individual and his or her identified location. Cumbers purports to teach a customer tracking system which uses passive biometric identification to identify customers (see Abstract). However, Cumbers does not teach or suggest several key elements of Applicants' independent claims 1, 8, and 15.

The Examiner admits that Cumbers does not disclose “computing a biometric signature corresponding to the biometric input” as taught and claimed by Applicants. Applicants respectfully submit that because Cumbers does not disclose computing a biometric signature, Cumbers also does not teach or suggest “comparing the biometric signature to one or more stored biometric signatures” as further taught and claimed by Applicants. Applicants use a biometric signature in order to securely and efficiently identify a person in a biometric data action list. As discussed by Applicants in their specification on page 10, line 16 through page 11, line 5, biometric action data includes biometric signatures of individuals that are actively being sought, and is a subset of a population of biometric data.

The Examiner cites Musgrave as disclosing using a hash function to create a biometric certificate, which the Examiner then asserts is analogous to a biometric signature. Musgrave purports to teach a biometric certification system for authenticating “electronic transactions involving a user” (Musgrave, col. 3, lines 32-33). Applicants do not agree that Musgrave’s biometric certificate is analogous to a biometric signature. As described by Applicants in their specification on page 8, lines 17-24, a biometric signature is generated by taking raw biometric data, sampling the data, aggregating the data, and then hashing the data into a biometric signature. In the example shown in Applicants’ specification, the raw biometric data is pictures of an individual. The biometric acquisition system samples various points of a person’s face, aggregates the samples, and then hashes them into a face attribute value (i.e. biometric signature).

The biometric certificate discussed in Musgrave is very different from a biometric signature as taught and claimed by Applicants. As shown in Figure 2 of Musgrave, a biometric certificate contains quite a bit of data, including a version number, serial number, issuer name, etc. The biometric certificate also includes biometric data 20. Part of the process of creating a biometric certificate includes processing an authenticating certificate, and one method discussed for processing such an authenticating certificate includes hashing (col. 5, lines 15-26). Once processed, the hashed value is sent to a registration authority which includes a biometric certificate generator (col. 5, lines 27-35). However, Musgrave does not teach or suggest “computing a biometric signature corresponding to the biometric input” as taught and claimed by Applicants. While Musgrave may use hashing to process an authenticating certificate, this is

simply not analogous to “computing a biometric signature corresponding to the biometric input” as taught and claimed by Applicants. Further, because neither Cumbers nor Musgrave teaches or suggests “computing a biometric signature,” Applicants respectfully submit that neither Cumbers nor Musgrave teaches or suggests “comparing the biometric signature to one or more stored biometric signatures” as also taught and claimed by Applicants in independent claims 1, 8, and 15.

Applicants also disagree with the Examiner’s statement that Cumbers and Musgrave are analogous art because they are from the same field of endeavor of biometric identification for commercial purposes. Applicants respectfully submit that there is simply no motivation, found in the prior art, to combine the customer identification and tracking system disclosed by Cumbers with the electronic authentication system of Musgrave. Instead, Applicants respectfully submit that the present Office Action improperly used Applicants’ claims as “guideposts” in selecting the references and simply concluded that it would be “obvious” to combine the references. In doing so, Applicants assert that the present Office Action used impermissible hindsight in combining Cumbers and Musgrave in order to support a rejection of Applicant’s claims.

MPEP § 706 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a

convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

Applicants assert that the Office Action fails to satisfy the burden set forth in § 706.02(j) in support of an obviousness objection, particularly because there is no motivation to combine the references. *Cumbers* seeks to identify and track customers in real-time, as they physically enter or move about an establishment, such as a restaurant, night club, casino, hotel, etc. (*Cumbers*, col. 3, lines 53-67). On the other hand, *Musgrave* is concerned with a biometric certification system for authenticating "electronic transactions involving a user" (*Musgrave*, col. 3, lines 32-33). These electronic transactions, or telecommunications-based transactions, are "conducted remotely and sight unseen" (*Musgrave*, col. 1, lines 23-27). The telecommunications-based transactions with which *Musgrave* is concerned are those which involve "a remote user of electronic service" (*Musgrave*, col. 1, lines 28-45). Applicants fail to see why it would be obvious to combine the real-time customer identification and tracking system of *Cumbers* with the remote authentication system of *Musgrave*.

Furthermore, the Office Action fails to explain how combining the customer identification system of *Cumbers* with the remote authentication system of *Musgrave* would

result in a workable solution. The point of Cumbers is to recognize customers, while the point of Musgrave is to find a way to authenticate users when they can not be seen and/or recognized. Musgrave's authentication system would seem to require a customer to purposely hide from or circumvent Cumbers' customer identification and tracking system.

The Examiner also relies on Musgrave to reject dependent claims 3, 4, 10, 11, 17, and 18. Applicants respectfully submit that the Examiner's reliance on Musgrave is misplaced with regard to these claims as well, for the reasons set forth above.

The Examiner relies on yet a third reference, Maeno, to reject dependent claims 5-7, 12-14, and 19-21. Maeno purports to teach a crime prevention monitor system, however, Applicants respectfully submit that Maeno does not overcome the deficiencies of Cumbers and Musgrave. Dependent claims 5-7 depend from independent claim 1, dependent claims 12-14 depend from independent claim 8, and dependent claims 19-21 depend from independent claim 15. No combination of the prior art cited by the Examiner teaches or suggests Applicants' system, method, and computer program product, as taught and claimed in independent claims 1, 8, and 15. Therefore, Applicants respectfully submit that independent claims 1, 8, and 15, and the claims that depend from them, are patentable, and respectfully request that they be passed to issue.

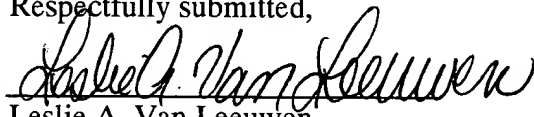
Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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